

REMARKS

This Amendment is made in response to the Office Action dated March 27, 2008. Claims 1-4, 6-15, 17, 18, 21, 32 and 34-42 were pending in this application. By this Amendment, method claims 34-41 have been canceled without prejudice. New claims 43-52 are being presented for consideration. Favorable reconsideration is respectfully requested.

Claims 1, 3, 6 and 7 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,609,627 to Goicoechea (the "Goicoechea patent"). Claims 2, 4, 6, 7, 32 and 33 were rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as being obvious over the Goicoechea patent. Applicants strongly disagree with the Examiner's position that the Goicoechea patent discloses a marker having a V-shaped mounting region and projecting fingers which apply a force on the V-shaped mounting region to hold the radiopaque marker on the marker holder. Applicants note that the Examiner has taken the position that the Goicoechea patent discloses projecting fingers which apply a force on the V-shaped mounting region when the stent is expanded to hold the radiopaque marker on the marker holder. Applicants respectfully point out to the Examiner that there is no disclosure in the Goicoechea patent to support this position. Moreover, the Examiner states at paragraph 8 of the Office Action that "Goicoechea teaches a radiopaque marker attached to the marker holder, but is silent as to how the marker is attached." Applicants respectfully point out that the Goicoechea patent does indicate how the wire 17 is attached to the end of the stent 16. The Goicoechea patent states the following:

An x-ray opaque marker may be attached to one or more ends of a stent so that the delivery of the stent can be monitored using x-rays. As shown in FIG. 4(a), such a radiopaque marker may typically comprise a gold or platinum wire 17 **crimped onto** an end of stent 16. (Column 10, lines 52-56, emphasis added).

Therefore, the Goicoechea patent does indeed indicate that this wire marker is crimped onto the end 16 of the stent. Therefore, there is no basis for the Examiner's

position that the projecting fingers apply a force to the mounting region to hold the radiopaque marker on the marker holder. Rather, the wire is crimped onto the end of the stent. Accordingly, the particular structure defined by claims 1, 2, 3, 4, 6, 7, 32 and 33 is not disclosed in the Goicoechea patent. Moreover, the Examiner states that the phrase "by a heat weld" is being treated as a Product by Process limitation. Applicants respectfully point out to the Examiner that this phrase was eliminated from claims 2 and 4 in the previous Amendment dated January 11, 2008. These claims now positively recited the weld as a structural element. Therefore, the Examiner's position to treat claims 2 and 4 as having Product by Process limitations was incorrect. The Goicoechea patent does not disclose the use of welds to connect elements together. Rather, a crimping step is implemented. Applicants respectfully request the Examiner to withdraw the rejections of these claims based on the Goicoechea patent.

Claims 8-15, 17, 18 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Goicoechea patent in view of U. S. Patent No. 6,503,271 to Duerig et al. (the "Duerig patent"). Independent claim 8 includes the recitation that the projecting fingers applying a force on the V-shaped mounting region to hold the radiopaque marker on the marker holder. Applicants again note, as was addressed above, that the Goicoechea patent fails to disclose such a structure. These claims further a radiopaque marker made from a nickel-titanium alloy including a ternary element which attains a level of radiopacity greater than the material forming the structural body. In the Office Action, the Examiner acknowledges that this structure is also lacking in the Goicoechea patent. The Goicoechea patent also fails to disclose the use of a weld to connect the radiopaque marker to the marker holder. Applicants respectfully point out to the Examiner that the phrase "by a heat weld" was eliminated from claims 14 and 17 in the previous Amendment dated January 11, 2008. These claims now positively recited the weld as a structural element. Therefore, the Examiner's position to treat claims 14 and 17 as having Product by Process limitations was incorrect. The Goicoechea patent does not disclose the use of welds to connect elements together. Rather, as stated above,

a crimping step is implemented. Therefore, the Goicoechea patent lacks even the basic components recited in the claims at issue.

The Duerig patent likewise lacks all of these same elements recited in these claims. Therefore, the combination of the Goicoechea patent with the Duerig patent fails to achieve the structure recited in the pending claims. Moreover, the Duerig patent discloses a marker consisting of a tab 200 integrally formed on the stent (the structural body). Both the tab 200 and the stent are made from the same binary nickel-titanium. The marker consists of a radiopaque material which is melted with the tab 200 to create a sphere 300 that is more radiopaque than the remainder of the stent. In the presently claimed invention, the marker is made from a ternary nickel-titanium alloy which is attachable to a marker holder. This particular structure is simply not disclosed in the Duerig patent. Moreover, if the Duerig patent was combined with the Goicoechea patent, then the teachings of the Duerig patent would dictate that the end of the stent should be heated with the wire 17 to melt these two components together to form a sphere-like structure. Again, this is not the structure recited in the claims at issue. Applicants respectfully request the Examiner to withdraw the rejections of these claims based on the combination of the Goicoechea patent and Duerig patent.

Claims 1-4, 6, 7, 32 and 42 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,741,327 to Frantzen (the "Frantzen patent") in view of U.S. Patent No. 6,520,934 to Lee (the "Lee patent"). Applicants note that the marker in the Frantzen patent relies on a knob 94 which is adapted to fit within a rounded space 62. The knob 94 has a width similar to the width of the rounded space 62 (See column 9, lines 37-38 of the Frantzen patent). The Examiner acknowledges that the Frantzen patent fails to disclose the use of projecting fingers that apply force on the V-shaped mounting region in order to hold the radiopaque marker on the marker holder. Since the knob 94 is the same width as the space 62 in the Frantzen patent, the "fingers" forming the space 62 fails to achieve a force on the knob 94 to hold it in place. Rather, the knob 94 is melted and allowed to resolidify within the space 62 in order to lock it in place (See column 9,

lines 55-60 of the Frantzen patent). For this reason, Applicants strongly disagree with the Examiner's position that the Frantzen patent discloses projecting fingers which move laterally to accept the radiopaque marker. The Frantzen patent makes no reference of these "fingers" moving in order to accept the knob 94 (marker). Rather, these fingers remain stationary so that the profile created by the fingers matches the profile of the knob 94.

Moreover, the Frantzen patent fails to disclose a notched region as recited in claim 3. The Examiner points to an area of the stent in the Frantzen device which is simply the intersection of the finger with the stent strut. It is not a notched region nor does this area allow the projecting fingers to move laterally. The Frantzen device also fails to disclose the structure recited in claim 6, namely, a V- shaped opening defined by the projecting fingers which defines a particular first angle when the pair of projecting fingers are unattached to the marker, along with a V-shaped mounting region of the radiopaque marker defines an angle which is larger than the first angle of the V-shaped opening. Claims 7 and 32 requires the mounting region of the radiopaque marker to be larger than the opening defined by the projecting fingers. Claim 42 still further requires a pair of projecting fingers extending away from the structural body to form an opening having a first shape and each radiopaque marker includes a mounting region having substantially the same shape as the first shape of the opening formed by the projecting fingers, each mounting region including side edges adapted to contact the projecting fingers of a marker holder to cause the projecting fingers to move outward to move the opening into a second, expanded shape. The Examiner references a statement appearing in the Frantzen patent which states that "while the knob 94 is preferably shown as round and matching the rounded space 62, various different matching patterns for the knob 94 and rounded space 62 could be successfully utilized ... so long as the knob 94 can be oriented within the rounded space 62." (Col. 9, lines 43-49) However, this statement appearing in the Frantzen patent, in fact, teaches away from the structure of claims 6, 7, 32 and 42 since this statement indicates that the knob 94 should match and fit within the rounded space

62. There is simply no support in the Frantzen patent for the structure recited in claims 6, 7, 32 and 42. Accordingly, the basic structure defined by claims 1-4, 6, 7, 32 and 42 is simply not disclosed in the Frantzen patent.

The Lee patent fails to disclose the structure lacking in the Frantzen patent. Applicants note that while the Examiner takes the position that the Lee patent discloses the use of applying a force to secure a marker in place, the Examiner does not specifically cite to the specification of Lee that supports this position. Moreover, Applicants note that there is no disclosure in the Lee patent of projecting fingers that apply a force on the V-shaped mounting region to hold a radiopaque marker on the marker holder. Applicants submit that the combination of the Frantzen patent with the Lee patent suggested by the Examiner simply fails to disclose the particular structure recited in these claims and therefore, the Examiner has failed to establish a prima facie case of obviousness. Applicants respectfully request the Examiner to withdraw the rejections of these claims based on the Frantzen and Lee patents.

Claims 8-15, 17, 18 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Frantzen patent in view of the Lee patent and in further view of the Duerig patent. Again, claim 8 includes the recitation that the projecting fingers applying a force on the V-shaped mounting region to hold the radiopaque marker on the marker holder. Applicants again note, as discussed above, that the Frantzen patent fails to disclose such a structure. Even the Examiner acknowledges that the Frantzen patent fails to this feature (See paragraph 18 of the March 27 Office Action). Accordingly, the basic structure defined by claims 8-15, 17, 18 and 21 is not disclosed in the Frantzen patent. Additionally, both the Lee patent and Duerig patent fail to disclose such a structure, as was discussed above. Therefore, the combination of the Frantzen patent and the Lee and Duerig patents fails to achieve the structure recited in claims 8-15, 17, 18 and 21. Applicants again respectfully request the Examiner to withdraw the rejections of these claims based on the combination of the Frantzen patent and Duerig patent.

New claims 43-52 also are directed to implantable medical devices which Applicants believe are patentable over the art of record for at least the reasons stated above. Favorable allowance of these new claims is also respectfully requested. Claim 43 is similar to claim 42 in that the structure includes a plurality of marker holders, each including a pair of projecting fingers extending away from the structural body to form an opening having a first shape. A plurality of radiopaque markers made from a nickel-titanium-platinum alloy can be attached within the marker holders. Each marker holder includes a mounting region having substantially the same shape as the first shape of the opening formed by the projecting fingers. The mounting region including side edges adapted to contact the projecting fingers to cause the fingers to move outwards to move the opening into a second, expanded shape. It is believed that this particular structure is not shown in the prior art of record.

In view of the foregoing, it is respectfully urged that all of the present claims of the application are patentable and in a condition for allowance. The undersigned attorney can be reached at (310) 824-5555 to facilitate prosecution of this application, if necessary.

In light of the above amendments and remarks, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

The commissioner is authorized to charge any deficiencies in fees or credit any overpayments to our Deposit Account No. 06-2425.

Respectfully submitted,
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